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MESSAGE:

Applicant: Mark Tuszynski
Title: MUTANT PRO-NEUROTROPHIN WITH IMPROVED ACTIVITY
Appl. No.: 09/788,188
Filing Date: 02/16/2001

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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant: Mark Tuszynski

Title: MUTANT PRO-NEUROTROPHIN WITH IMPROVED ACTIVITY

Appl. No.: 09/788,188

Filing Date: 02/16/2001

Examiner: Chen, Shin-Lin

Art Unit: 1632

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TRANSMITTAL

Commissioner for Patents
Box NON-FEE AMENDMENT
Washington, D.C. 20231

Sir:

In the above-identified application, transmitted herewith are:

[X] Supplemental Response to Restriction Requirement and Preliminary Amendment.

The Commissioner is hereby authorized to charge any additional fees which may be required regarding this application under 37 C.F.R. §§ 1.16-1.17, or credit any overpayment, to Deposit Account No. 50-0872. Should no proper payment be enclosed herewith, as by a check being in the wrong amount, unsigned, post-dated, otherwise improper or informal or even entirely missing, the Commissioner is authorized to charge the unpaid amount to Deposit Account No. 50-0872.

Atty. Dkt. No. 041673-2045

Respectfully submitted,

Date 3-14-03

By Stacy L. Taylor

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Atty. Dkt. No. 041673-2045

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant: Mark Tuszynski, *et al.*

Title: MUTANT PRO-NEUROTROPHIN WITH IMPROVED ACTIVITY

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SUPPLEMENTAL RESPONSE TO RESTRICTION REQUIREMENT

AND PRELIMINARY AMENDMENT

Commissioner for Patents
Box NON-FEE AMENDMENT
Washington, D.C. 20231

Sir:

I. Amendment.

Prior to examination of the pending claims, please amend Claim 9 to read as follows. A marked up copy of the amended claim is submitted herewith.

B1

9. (Amended) A mutant pro-neurotrophin precursor polypeptide selected from the group of polypeptides consisting of SEQ.ID.Nos. 2, 4, 6 and 8.

Applicant requests entry of the foregoing preliminary amendment to correct Claim 9. The amendment is made to clarify that the claim is directed not to the wild-type pro-neurotrophins of SEQ.ID.Nos. 1, 3, 5 and 7, but instead to the mutated forms of those proteins, of SEQ. ID.Nos. 2, 4, 6 and 8.

Atty. Dkt. No. 041673-2045

II. Supplemental Response to Restriction Requirement.

In the further restriction requirement set forth in the Office Action mailed December 19, 2002, the Examiner has required restriction between, in the elected Group I, SEQ.ID.Nos. 1, 3, 5 and 7, each drawn to a polypeptide.

Applicant respectfully traverses the requirement to restrict the claims between the sequences identified in Claim 9, and covered by Claims 1-8 and 10 (together forming the previously elected Group I), for the following reasons.

Claim 9 confirms that SEQ.ID. Nos. 2, 4, 6 and 8 are claimed as a Markush group of alternative polypeptides. As discussed in MPEP §803.02, restriction cannot be required between members of a Markush grouping. Withdrawal of the restriction requirement between these members of the Markush grouping is therefore requested.

MPEP §803.02 does permit the Office to require election of a *species* among members of a Markush grouping. In the interest of compact prosecution, Applicants will address this possibility as well.

Such a species election would only be appropriate if "two or more members [of the Markush group] are so unrelated and diverse that a prior art reference anticipating the claim with respect to one of the members would not render the claim obvious under 25 U.S.C. 103 with respect to the other member(s)." MPEP §803.02, third paragraph. Here, however, the members of the Markush grouping are not unrelated.

As taught in the Specification (see, e.g., page 3, lines 28-32), pro-neurotrophins "contain at least one N-glycosylation sequence which is completely conserved throughout the family. The invention targets at least one of those sequences. In particular, the substitution is of a basic residue for an asparagine."

The mutant polypeptides of Claims 1-10 (elected Group I) all contain the same N-glycosylation sequence and the same kind of mutation in that sequence, as described. Thus, although the source of that sequence is any protein within the family of neurotrophins, the sequence and mutations do not vary between the different neurotrophins. As such, the members of the Markush group are neither unrelated nor

diverse; instead, they are the same sequence, albeit contained in different neurotrophins (e.g., per Claim 9, NGF, BDNF, NT3 and NT-4/5). Thus, no basis exists upon which a single species of invention could be elected within the grouping identified by the Examiner.

For all of the foregoing reasons, withdrawal of the further restriction requirement between the polypeptides/SEQ.ID. Nos. of Group I is respectfully requested. Examination of Claims 1-10, and favorable consideration thereof, is also requested.

Respectfully submitted,

Date 3-14-03

By Stacy L. Taylor

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